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| APPLICATION NO.                   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------|-------------|----------------------|---------------------|------------------|
| 09/814,288                        | 03/21/2001  | Noriko Ito           | 14419               | 4794             |
| 23389                             | 7590        | 05/05/2005           | EXAMINER            |                  |
| SCULLY SCOTT MURPHY & PRESSER, PC |             |                      | LASTRA, DANIEL      |                  |
| 400 GARDEN CITY PLAZA             |             |                      | ART UNIT            | PAPER NUMBER     |
| SUITE 300                         |             |                      |                     |                  |
| GARDEN CITY, NY 11530             |             |                      | 3622                |                  |

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |              |
|------------------------------|-----------------|--------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s) |
|                              | 09/814,288      | ITO, NORIKO  |
|                              | Examiner        | Art Unit     |
|                              | DANIEL LASTRA   | 3622         |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 January 2005.

2a) This action is **FINAL**.                                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-17 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.



### **DETAILED ACTION**

1. Claims 1-17 have been examined. Application 09/814,288 (ADVERTISEMENT PROVIDING SYSTEM AND METHOD) has a filing date 03/21/2001 and foreign priority of 03/30/00.

#### ***Response to Amendment***

2. In response to Non Final Rejection filed 10/04/04, the Applicant amended claims 1, 6, 9, and 14-17. Applicant amendment overcame the previous Section 112 and 101 rejection.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites "means for calculating a schedule time of the communication dealer terminal". For purpose of art rejection, the Examiner would interpret the claim to mean calculating a schedule time of consumer's arrival at a shop from a present position of the consumer.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz et al (U.S. 6,571,279) in view of Hall et al (US 6,026,375).

As per claims 1, 9 and 17, Herz teaches:

An advertisement providing system comprising a communication line, one or more communication dealer terminals, one or more consumer terminals and one or more company terminals, these terminals being interconnected by the communication line, wherein:

each communication dealer terminal includes a means for storing advertisement data and also consumer's position data and taste data, a means for selecting advertisement data for each consumer by taking the consumer's position data and taste data, and a *current* time into considerations (see Herz column 25, line 10 – column 26, line 62). Herz does not expressly teach *and a means for calculating a schedule time of consumer's arrival at a shop from a present position of the consumer and for transmitting the schedule time to a company terminal*. However, Hall teaches "a method of processing an order from a mobile customer comprises receiving an order from a mobile customer, wherein the order includes customer identifying information; receiving customer location information from a location determination system; identifying at least one facility capable of completing the order; determining an estimated time of arrival of the customer at each identified facility using the customer location information; determining an amount of time needed by each identified facility to complete the order; and determining which facility of the at least one identified facility is capable of completing the order prior to the customer's estimated time of arrival at the determined

facility" (see column 2, lines 49-61). Herz discloses in column 26, lines 49-60 "Once relevant products are identified, a user en route to a destination near a vendor's store can pre-order their groceries or other merchandise directly so that the user could simply pick up their pre-packaged grocery order at the time of arrival at the store. For example, an advertisement for a product on an electronic billboard could easily be pre-ordered from the user's automobile or device". Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that once a customer is en route to a destination near a vendor's store identifies relevant products, said customer would preorder their order and the Herz system would determine the estimated time of arrival of said customer to said vendor's store based upon said customer's location, as taught by Hall . This schedule time information would be used by said store to reduce waiting time of said customer upon arrival at said store.

each consumer terminal includes a means for displaying advertisement data received from a communication dealer terminal, a means for transmitting the consumer terminal's position data to the communication dealer terminal, and a means for transmitting reservation request data for a product or a service selected by the consumer on the basis of the advertisement data received (see Herz column 26, lines 49-62); and

each company terminal includes a means for producing advertisement data and transmitting the produced advertisement data to the communication dealer terminal (see Herz column 16, lines 7-34),

a means for receiving the reservation request data via the communication dealer terminal and executing a reservation process, a means for *checking*, when the consumer comes to a shop, whether the consumer has requested a reservation and *outputting a result of the checking* (see Herz column 26, lines 29-62).

As per claims 2 and 10, Herz teaches:

The advertisement providing system according to claim 1, wherein the communication dealer terminal transmits the advertisement data as electronic mail to the consumer terminal (see column 8, lines 51-65).

As per claims 3 and 11, Herz teaches:

The advertisement providing system according to claim 1, wherein the consumer terminal transmits the reservation request data as electronic mail to the communication dealer terminal (see column 25, lines 25-67).

As per claims 4 and 12, Herz teaches:

The advertisement providing system according to claim 1, wherein the communication dealer terminal transmits the reservation request data as electronic mail to the company terminal (see column 26, lines 29-62).

As per claims 5 and 13, Herz teaches:

The advertisement providing system according to claim 1, wherein the communication line is an Internet system (see column 25, lines 55-67).

As per claims 6 and 14, Herz teaches:

The advertisement providing system according to claim 1, wherein the means for calculating a scheduled time of the communication dealer terminal calculates the

*schedule time based on the present position of the consumer, the position of the shop as described in the advertisement and the present time (see column 5, line 50 – column 6, line 15; column 25, lines 25-40; column 26, lines 49-62).*

As per claims 7 and 15, Herz teaches:

The advertisement providing system according to claim 1, wherein the communication dealer terminal further includes a means for calculating advertisement effect from the contract of advertisement requested to it and transmitted reservation request data of consumers (see column 25, lines 1-25).

As per claims 8 and 16, Herz teaches:

The advertisement providing system according to claim 7, wherein the communication dealer terminal further includes a means for determining advertisement fee from the advertisement effect (see column 5, lines 15-35).

#### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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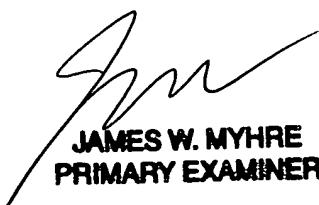
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720. The examiner can normally be reached on 9:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 571-272-6724. The right-fax phone number of the Examiner is 571-273-6724.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Daniel Lastra  
April 26, 2005

  
JAMES W. MYHRE  
PRIMARY EXAMINER